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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,667	10/23/2000	Julie B. Madison	LERNER1.024C2	9829

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EXAMINER

DANG, HUNG XUAN

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/694,667	MADISON, JULIE B.	
	Examiner	Art Unit	
	Hung X Dang	2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29,32-50 and 59-108 is/are pending in the application.
- 4a) Of the above claim(s) 29, 30-50,59-95, 107 and 108 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 96-106 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>10</u> . | 6) <input type="checkbox"/> Other: _____ |

Applicant's election without traverse of group I, specie B, claims 96-106 in Paper No. 17 is acknowledged.

Information Disclosure Statement

1. The Information disclosure Statements filed on 3/19/03 has been considered.
2. Claims 101 and 106 are objected to because of the following informalities:
"oneanother" in line 2 should be changed to --one another--. Appropriate correction is required.

Claims Rejection Under 35 USC - 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 96-100 and 102-104 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Nishioka** (5,642,177).

Nishioka discloses detachable sunglasses with magnet which comprises a first lens frame for holding a first lens, a second lens frame for holding a second lens, a first attachment housing extending from a first frame, a second attachment housing extending from a second frame, and a pair of temples hingedly connected to respective ones of the attachment housings and extending rearwardly from the frames to secure

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the eyewear on a wearer thereof, each of the attachment housings having a rearwardly directed surface with a bore formed therein, a first magnetic member (7) embedded within the bore of the first attachment housing and a second magnetic member (7) embedded within the bore of the second attachment housing, the magnetic members being adapted to secure auxiliary lenses in superimposed relation to the first and second lenses.

Claims Rejection Under 35 USC - 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 101 and 106 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nishioka** (5,642,177) in view of **Nerney** (1,613,765).

Nishioka discloses detachable sunglasses with magnet which comprises a first lens frame for holding a first lens, a second lens frame for holding a second lens, a first attachment housing extending from a first frame, a second attachment housing extending from a second frame, and a pair of temples hingedly connected to respective ones of the attachment housings and extending rearwardly from the frames to secure the eyewear on a wearer thereof, each of the attachment housings having a rearwardly

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directed surface with a bore formed therein, a first magnetic member (7) embedded within the bore of the first attachment housing and a second magnetic member (7) embedded within the bore of the second attachment housing, the magnetic members being adapted to secure auxiliary lenses in superimposed relation to the first and second lenses.

Nishioka does not disclose an attachment housing having an upper section and a lower section detachably secured to one another.

Nerney, however, discloses an attachment housing having an upper section and a lower section detachably secured to one another.

Because Nishioka and Nerney are both from the same field of endeavor, the purpose of easy changing lenses as disclosed by Nerney would have been recognized as an art pertinent art of Nishioka.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses frame, such as the one disclosed by Nishioka, with an attachment housing having an upper section and a lower section detachably secured to one another, such as disclosed by Nerney for the purpose of easy changing lenses.

Claims Rejection Under 35 USC - 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 105 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Nishioka** (5,642,177) in view of **Chao** (5,568,207).

Nishioka discloses detachable sunglasses with magnet which comprises a first lens frame for holding a first lens, a second lens frame for holding a second lens, a first attachment housing extending from a first frame, a second attachment housing extending from a second frame, and a pair of temples hingedly connected to respective ones of the attachment housings and extending rearwardly from the frames to secure the eyewear on a wearer thereof, each of the attachment housings having a rearwardly directed surface with a bore formed therein, a first magnetic member (7) embedded within the bore of the first attachment housing and a second magnetic member (7) embedded within the bore of the second attachment housing, the magnetic members being adapted to secure auxiliary lenses in superimposed relation to the first and second lenses.

Nishioka does not disclose an arm of the auxiliary engagable with the rearwardly directed surface of the attachment housing.

Chao, however, discloses an arm of the auxiliary engagable with the rearwardly directed surface of the attachment housing.

Because Nishioka and Chao are both from the same field of endeavor, the purpose of stably attached as disclosed by Chao would have been recognized as an art pertinent art of Nishioka.

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It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses frame, such as the one disclosed by Nishioka, with an arms of the auxiliary engagable with the rearwardly directed surface of the attachment housing, such as disclosed by Chao for the purpose of stably attached.

6. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (703) 308-0550.

7/03



HUNG DANG

PRIMARY EXAMINER

TC 2800